



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/631,470	04/12/1996	STALEY BROD	D5716CIP2	.5157

27851 7590 07/30/2003

BENJAMIN A. ADLER
8011 CANDLE LANE
HOUSTON, TX 77071

EXAMINER

SAYALA, CHHAYA D

ART UNIT	PAPER NUMBER
----------	--------------

1761

DATE MAILED: 07/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application N .

08/631,470

Applicant(s)

BROD, STALEY

Examiner

C. SAYALA

Art Unit

1761

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,5-9 and 12-19 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-3,5-9 and 12-19 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948) *see paper #2*
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 5) ☒ Notice of Informal Patent Application (PTO-152) *see paper #5*
- 6) ☐ Other:

Art Unit: 1761

DETAILED ACTION

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 13-15 and 17-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Cummins, Jr. (US Patent 5019382).

The above claims continue to be rejected as being anticipated by the reference for the same reasons as discussed by the Board of Patent Appeals and Interferences. See Paper No. 22 for reasons.

3. Claims 1-3, 6-7, 13-18 are rejected under 35 U.S.C. 102(e) as being anticipated by Sobel (US Patent 5780021, which is an equivalent of WO 94/02154).

Sobel teaches the oral administration (col. 13, line 10+) of a Type I interferon for auto-immune diseases, including diabetes, listed at col 1 and col. 2, lines 5-30 in the same doses claimed herein, at col. 4, lines 10-25. The species to be treated are listed at col. 4 and col. Col. 11, lines 35+. Note that at col. 10, the patentee notes that the treatment reduces inflammatory response and at col. 11, line 20, that it inhibits recurrent diabetes.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 5-10, 12-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sobel and Cummins, Jr.

Sobel teaches all of the limitations of the claims listed and discussed in paragraph 2 above. The patentee does not teach alternate day dosing and does not teach MS in particular, although he does teach the therapy for auto-immune diseases and it is well known that MS is a auto-immune disease. See references listed in PTO-form 892, which shows state of the art and what is well known. Cummins also teaches

Art Unit: 1761

all of the limitations of the claims except the alternate day dosaging. However, he does show that a daily dosage is possible, as a single dosage or as divided and administered in a multiple daily dose regimen. The reference also teaches a staggered regimen of 1-3 days per week or month as an alternative to daily dosing. See col. 5, lines 50-55.

With such a flexibility as taught by the reference, and since it is common knowledge in the art to employ such a regimen instead of continuous dosing, for a variety of reasons such as, toxicity, the condition of the patient, patient reaction and amelioration of the disease condition, etc., it would have been obvious to one of ordinary skill in the art to adopt an alternate day dosing and administer IFN as shown by Cummins for MS. It is worthwhile to note that even though Sobel teaches the same amounts, patentee states that the precise amount will depend on the judgement of the attending physician based on considerations of age, weight and condition of the patient.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to C. SAYALA at Group 1761, telephone number (703) 308-3035.

The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3599.

Application/Control Number: 08/631,470

Page 5

Art Unit: 1761

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is 703-308-0661.

A handwritten signature in cursive script, appearing to read 'C. Sayala'.

C. SAYALA
Primary Examiner
Group 1700.